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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,579	06/23/2003	Joseph Sery	81571	9643

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EXAMINER

BELLINGER, JASON R

ART UNIT PAPER NUMBER

3617

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/600,579

Applicant(s)

SERY, JOSEPH

Examiner

Jason R Bellinger

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 6-8 and 11-20 is/are rejected.
- 7) ☒ Claim(s) 2-5, 9 and 10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A (1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 13. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "12" has been used to designate both the "protruding retainers" in Figure 4 and the "leg portion" of the clip in Figure 7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claim 10 is objected to because of the following informalities: In line 3 of the claim, it is suggested that the term "hardens" be replaced with the term --hardened-- for grammatical clarity. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 11-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11 is indefinite due to the fact that the phrase "can be" in line 5 of the claim makes it unclear whether or not the high-density weight is secured within the body component of the assembly.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3617

8. Claims 1, 6, 11-12, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Kogure et al. In Figures 2b, 4a, and 4b, Kogure et al shows a balance weight assembly having a body 5 including a hook portion with a cross-sectional shape that corresponds to a flanged edge portion 4 of a wheel rim 3, and a cavity 8 for holding a separate high-density weight 6. The weight 6 is secured in the cavity 8 by a fill material having adhesive properties (see column 2, lines 59-62).

The high-density weight is a solid body of tungsten (see column 3, lines 27-31). The body 5 is a one-piece molded polymeric component (see column 3, lines 24-27). The body 5 is elongated and the clip portion is present at least at both longitudinal ends of the body 5.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kogure et al. Kogure et al contains all of the limitations set forth in paragraph 8 above, but does not specify that the high-density weight is formed of a body of tungsten powder having an apparent density of not less than 10 g/cc compounded with a polymeric binder. In column 3, lines 27-31, Kogure et al states that the weight may be formed from mixing tungsten powder with a polymeric binder. One of ordinary skill in the art at the

time of the invention would have found it obvious to provide an amount of tungsten powder having an apparent density suitable for producing a balance weight with sufficient mass to properly balance a wheel.

11. Claims 8, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kogure et al as applied to claims 1, 6-7, 11-12, and 16-17 above, and further in view of Bajer. Kogure et al does not show the balance weight being formed as a rod. Bajer teaches the use of a balance weight that is formed as a rod (see Figure 2). From this teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to form the balance weight of Kogure et al as a rod for the purpose of creating a visibly appealing weight and to decrease the amount of storage space required to store the weights.

12. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kogure et al as applied to claims 1, 6-7, 11-12, and 16-17 above, and further in view of Goto et al. Kogure et al does not disclose that the body is formed by an injection-molded polymer having a high creep resistance and/or high impact strength. Goto et al teaches the use of a polymer having a high creep resistance (see column 17, lines 61-64) that may be injection molded (see column 6, lines 47-52). From this teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to form the body of the balance weight assembly of Kogure et al from an injection molded polymer

Art Unit: 3617

with high anti-creep properties for the purpose of preventing distortion of the body and preserving the structural integrity of the balance weight assembly.

13. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kogure et al as applied to claims 1, 6-7, 11-12, and 16-17 above, and further in view of Smith. Kogure does not show the molded body being color-pigmented or electroplated. Smith teaches a molded body 100 having color pigmentation (see column 3, lines 30-39). Therefore from this teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to form the body of Kogure et al with color pigmentation for the purpose of increasing the visibility of the body for safety purposes.

Allowable Subject Matter

14. Claims 2-5, and 9-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. Claims 18-19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Art Unit: 3617

Conclusion



16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references are considered to show wheel balance weight assemblies having removable weights secured in a clip body. For example, Du Sang shows a balance weight assembly of the type described above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason R Bellinger whose telephone number is 703-308-6298. The examiner can normally be reached on Mon - Thurs (9:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on 703-308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason R Bellinger
Examiner
Art Unit 3617


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